

.14.

### **REMARKS**

Applicant has carefully reviewed the Application in light of the Office Action transmitted October 20, 2009 (“*Office Action*”). Claims 1-22, 24-26, and 33-39 are pending in the Application and stand rejected. In order to advance prosecution, Applicant has amended Claims 1-6, 8, 17, 21. No new matter has been added. Applicant respectfully requests reconsideration and favorable action in this case.

Applicant notes that Claim 8, 17, and 21 have been amended to correct typographical errors. No new matter has been added.

#### **I. Rejections under 35 U.S.C. § 101**

##### **A. Claims 35-38 are allowable because they recite statutory subject matter**

The *Office Action* rejects Claims 35-38 under 35 U.S.C. § 101 because they allegedly do not fall within one of the four categories of patentable subject matters of 35 U.S.C. § 101. *Office Action*, p. 2. To support this rejection, the *Office Action* alleges that the claims recite “a computer readable medium” which is allegedly described in the specification as logic and that logic, as best understood by the Examiner, is a program. *Id.* The Examiner contends that a program per se is not patentable subject matter. *Id.*

However, to the extent that Claims 35-38 covers embodiments that include software, that does not prevent the claim from being patentable under 35 U.S.C. § 101. Applicant notes that “a claimed computer readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.” M.P.E.P. § 2106.01.I. “Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence non-statutory.” M.P.E.P. § 2106.01.I. That is not the case here.

Among other things, Applicant’s specification points out that a “telephony device [] contemplates implementing each of the functional components using any suitable combination and arrangement of hardware and/or logic, and implementing any of the functionalities using a computer program stored on a computer readable medium.” Application, p. 19, lines 15-18. Contrary to the allegations in the *Office Action*, the

.15.

exemplary portion makes clear that “a computer readable medium,” “logic,” and a “program” are **not** the same thing. Moreover, as the exemplary portion demonstrates, the Application recites a “computer readable medium encoded with a computer program [] which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.” *See* M.P.E.P. § 2106.01.I.

**B. Claims 1-9 are allowable because they satisfy the *Bilski* machine-or-transformation test**

The *Office Action* rejects Claims 1-9 under 35 U.S.C. § 101 because allegedly they do not fall within one of the four categories of invention. *Office Action*, p. 2. To support this rejection, the *Office Action* alleges that Claims 1-9 neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps. *Id.* “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008). With regard to Claim 1, although Applicants believe that all previously pending claims recite statutory subject matter under § 101, to advance prosecution, Applicants currently amend Claim 1 to recite telephony and computing devices, thereby tying it to a particular machine or apparatus. Claims 2-9 depend from Claim 1 and thus recite statutory subject matter under § 101 for at least the same reason. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 1-9.

**II. Rejections under 35 U.S.C. § 103(a)**

**A. Claims 1-8, 10-17, 19, 20, 22, 24-26, and 33-39 are allowable over *Bales* and *Schroderus***

The *Office Action* rejects Claims 1-8, 10-17, 19, 20, 22, 24-26, and 33-39 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,574,724 to Bales, et al, (“*Bales*”) in view of U.S. Patent Publication No. US 2003/0223381 to Schroderus (“*Schroderus*”). Applicants respectfully traverse and submit that the proposed *Bales-Schroderus* combination fails to teach or suggest all elements of the claims.

.16.

Consider Applicant's independent Claim 1, which recites:

A method for supporting communications comprising:

establishing a packet-based audio communication link between a local telephony device and a remote telephony device;

informing a local computing device coupled to the local telephony device of the audio communication link;

receiving a message from the local computing device, the message requesting identification of enhanced media capabilities associated with a remote computing device coupled to the remote telephony device;

tunneling the message in the audio communication link to the remote telephony device;

receiving a tunneled response in the audio communication link from the remote telephony device, the response identifying the enhanced media capabilities associated with the remote computing device; and

forwarding the response to the local computing device.

Among other aspects of the claims, the cited references do not disclose "receiving a message from the local computing device" wherein "the message request[s] identification of enhanced media capabilities associated with a remote computing device coupled to the remote telephony device," as Claim 1 requires.

As teaching these claimed aspects of Claim 1, the *Office Action* points to column 3, lines 32-60 of *Bales*. *Office Action*, p. 4. The cited portion, among other things, describes steps for requesting the addition or removal of video bandwidth during a call. *See Bales*, 3:32-60. While *Bales* may disclose the existence of a communication terminal on either end of a call and requesting an adjustment of bandwidth during that call (*see id.*), the cited portion fails to teach "a remote computing device coupled to [a] remote telephony device" and "receiving a message from the local computing device . . . requesting identification of enhanced media capabilities associated with [such] a remote computing device," as Claim 1 requires. Likewise, *Schroderus* fails to disclose these concepts.

Independent Claims 10, 19, 22, 33, 35, and 39 include limitations that, for substantially similar reasons, are not disclosed by *Bales*. Thus, the proposed combination of *Bales* and *Schroderus* does not disclose, expressly or inherently, every element of

.17.

independent Claims 1, 10, 35, and 39. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 1, 10, 35, and 39 and their respective dependent claims.

**B. Claims 9, 18, and 21 are allowable over *Bales* and *Bowman-Amuah***

The *Office Action* rejects Claims 9, 18, and 21 under 35 U.S.C. § 103(a) as unpatentable over *Bales* in view of U.S. Patent No. 6,434,568 to Bowman-Amuah (“*Bowman-Amuah*”). For the reasons indicated above, *Bales* fails to disclose, expressly or inherently, every element of independent Claims 1, 10, and 19. *Bowman-Amuah* fails to cure this deficiency. Claims 9, 18, and 21 depend from independent Claims 1, 10, and 19, respectively, and thus are allowable over of the proposed combination of *Bales* and *Bowman-Amuah* for at least the same reason. Accordingly, Applicant respectfully requests reconsideration and allowance of dependent Claims 9, 18, and 21.

**III. No Waiver**

All of Applicant’s arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the *Office Action*. The example distinctions discussed by Applicant are sufficient to overcome the *Office Action*’s rejections. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the *Office Action*, Applicant does not acquiesce to the *Office Action*’s additional statements.

.18.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any additional amount required or to credit any overpayment to Deposit Account No. 02-0384 of Baker Botts LLP.

If the Examiner feels that prosecution of the present Application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney at 214-953-6584.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'K-P' followed by a horizontal line.

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Date: January 20, 2010

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